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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,463	10/07/2003	Jihyun Ahn		3161

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Jihyun Ahn
510 W. Bemont Ave. # 1410
Chicago, IL 60657

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,463

Applicant(s)

AHN, JIHYUN

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 20 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 20, 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 13 and 20 have been amended for further examination. Claims 1-12, 14-19 and 21-33 have been canceled. Claims 34-43 have been added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13, 20 and 34-43 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Strasbourg (CH-620,641A5) in view of Jones (GB413,243).

Strasbourg discloses in Fig. 1-3, and in Attachment I, a book comprising: a first plurality of sheets (n) having a peripheral edges with portions (E1, E2, E3, Bn, Un, and Dn) and oppositely facing front and back surfaces (not shown); a binding on a bound edge portion (on edge B, not directly shown) that maintains the sheets in a stacked arrangement; the peripheral edges (E1, E2, E3..En) configured so that a user can engage the book at a first location (A1...An) and flip directly from a first sheet (1) to a second sheet (3) by engaging the first sheet (1) and the second sheet (3) at or adjacent to the peripheral edges (En) without exposing the front surface of a third sheet (2, seen in Fig. 1) between the first sheet (1) and second sheet (3); wherein the peripheral edges of the sheet comprise a bound peripheral edge portion (Bn) and an opposite peripheral edge portion (En); the binding (B) located at the bound peripheral edge portions in the plurality of sheets; the opposite peripheral edge portions having a first length (Ln) between spaced ends (top and bottom edges (Un and Dn)); wherein the book has a substantially squared outer edge shape with the bound peripheral edge portions and opposite peripheral edge portions on the sheets extending generally parallel to a second reference line (V1); and wherein the front and back surfaces of the plurality of sheets can have indicia; a front cover (seen in Fig. 2).

However, Strasbourg does not disclose: a plurality of sheet wherein the user flips through the book form front to back to expose the front surface of the first sheet, the back surface of the sheet (third sheet) that directly overlies the first sheet can be viewed together with the front surface of the first sheet;

Jones discloses in Fig. 3, and on Page 3, Col. 2, lines 66-87, wherein one of the sheets can be shaped having a peripheral edge portion having an edge part extending along a line at a slight angle relative to the reference line of the book (Col. 2, lines 80-87), and wherein the edge parts extend more than half way the length of the page.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strasbourg's book with additional flip sheets having a variety of different cut shapes as taught by Jones for providing additional pages in which an end user can selectively flip through without exposing the surfaces of other pages.

In regards to **Claims 13, and 34-38**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any type of graphic indicia on the front and back surfaces of the bound sheets, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the

substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the bound sheets, since applicant has not disclosed the criticality of type of indicia, and invention would operate equally as well with any type of placed indicia.

In regards to **Claims 34-38**, wherein the sheet are configured so that a user flips through the book from front to back to expose the front surface of the first sheet, the back surface of the sheet (third sheet) that directly overlies the first sheet can be viewed together with the front surface of the first sheet, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the plurality of sheets can be configured for an end user to flip through the pages in any desirable manner.

Response to Arguments

3. Applicant's arguments filed on June 2, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments that the prior art does not disclose or suggest a book that can be grasped strategically at different locations and flipped to serially

expose front sheet and at the same time expose the back surfaces on the sheets directly overlying the front surfaces, and wherein the indicia material is a type that is related, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the plurality of sheets can be configured for an end user to flip through the pages in any desirable manner.

Prior Art

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Levine, Barker, and Carmichel et al discloses a similar book.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3722

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

July 24, 2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER